

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANT : Hoffmann *et al.* CONFIRMATION NO.: 9237
SERIAL NUMBER : 10/816,445 EXAMINER: Marshall M. Mcleod
FILING DATE : March 31, 2004 ART UNIT: 2457
FOR : MESSAGING PROTOCOL IN ENTERPRISE APPLICATIONS

Via EFS
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT
UNDER 37 C.F.R. 1.705(b)

Applicants request reconsideration of patent term adjustment for the above-referenced application. Also enclosed is the two-hundred dollar fee as required by 37 C.F.R. § 1.18(e).

Applicants received a Notice of Allowance and Fees Due from the U.S. Patent and Trademark Office, mailed on September 15, 2009, which stated that the Patent Term Adjustment under 35 U.S.C. 154(b) to date is 834 days. This Request is submitted in view of the decision by the U.S. District Court decision in *Wyeth v. Dudas* (D.D.C. 2008) on September 30, 2008 as well as Applicants' duty under 37 C.F.R. 1.765.

By this paper, Applicants hereby petition the U.S. Patent and Trademark Office for reconsideration of the patent term adjustment calculation to 1142 days based on the facts provided herein.

This patent application was filed on March 31, 2004 and is therefore subject to the patent term adjustment procedures set forth in 37 C.F.R. §§ 1.702 to 1.705 for applications filed on or after May 29, 2000.

On October 31, 2007, the Office mailed a Non-Final Office Action. The Action was mailed 883 days after the date that is fourteen-month requirement for mailing of the first action after the date on which the application was filed under 35 U.S.C. §111(a). As shown in the PAIR Patent Term Adjustment printout submitted as Exhibit A, the number of days of Patent Term Adjustment accounts for the 883 day Office delay.

On January 2, 2008, Applicants filed a Response to Non-Final Office Action. This Response was received within three months of the mailing date of the Action.

On April 17, 2008, the Office mailed a Final Office Action. This Action was mailed within the four months of the filing of the reply filed under 35 U.S.C. §132.

On September 4, 2008, Applicants filed a Request for Continued Examination with a two month extension of time. This Request was filed 49 days after the date that is three months after the mailing date of the Office Action. As shown in Exhibit A, the number of days of Patent Term Adjustment accounts for the 49 day Applicant delay.

On November 13, 2008, the Office mailed a Non-Final Office Action. This Action was mailed within the four months of the filing of the reply filed under 35 U.S.C. §132.

On February 13, 2009, Applicants filed a Response to Non-Final Office Action. This Response was filed within three months of the mailing date of the Action.

On May 19, 2009, the Office mailed a Restriction Requirement. This Restriction was mailed within the four months of the filing of the reply filed under 35 U.S.C. §132.

On June 19, 2009, Applicants filed a Response to Restriction Requirement. This Response was filed within three months of the mailing date of the Action.

On September 15, 2009, the Office mailed the Notice of Allowance/Notice of Allowability, and the Determination of Patent Term Adjustment for this application. This Notice was mailed within the four months of the filing of the reply filed under 35 U.S.C. §132. The Determination of Patent Term Adjustment noted an adjustment period for this patent application of 834 days. As indicated in Exhibit A, the Office delay for this application is indicated as 883 days and Applicants' delay is 49 days.

According to the provisions of 37 C.F.R. §1.702(b), Applicants are entitled to Patent Term Adjustment for the failure of the Office to issue the patent within three years after the date on which the application was filed. Under 37 C.F.R. §1.702(b)(1)-(5), Applicants are entitled to this adjustment for any time other than time consumed by continued examination of the application requested by the applicant under section 132(b), beginning on the date on which a Request for Continued Examination was filed, September 4, 2008, and ending on the date the patent issues.

The amount of the Adjustment under 37 C.F.R. §1.702(b) is calculated from April 1, 2007 (*i.e.*, the day after the date that is three years from the date that the application was filed),

through the day before the date the Request for Continued Examination was filed, *i.e.* September 3, 2008, subtracting only time legitimately attributable to Applicant delay. Applicants note that from April 1, 2007 through October 31, 2007, *i.e.* 214 days, delay under 37 C.F.R. 1.702(a) and 37 C.F.R. 1.702(b) overlap. Applicants submit that the Adjustment under 37 C.F.R. §1.702(b) is 522-214 = 308 days.

Applicants have calculated the Patent Term Adjustment based on 37 C.F.R. 1.702(a), 37 C.F.R. 1.702(b) and 37 C.F.R. 1.704 through the mailing of the Notice of Allowance. The total calculation of Patent Term Adjustment is as follows: Office delay under 37 CFR 1.702(a) is 883 days; Office Delay under 37 CFR 1.702(b) is 308 days; and Applicant delay under 37 CFR 1.704(c) is: 49 days, adjustment is **883+308-49 = 1142 days**.

Applicants reserve the right to request any further patent term adjustment based on the actual issue date of the instant application.

If the Office would like to discuss any aspect of this filing, the Office representative assigned to process this request is welcome to call the undersigned attorneys. No additional fees are believed to be due by submission of this paper. However, the Commissioner is hereby authorized to charge any additional fees that may be due, or credit any overpayment of same, to Deposit Account No. 50-0311, Reference No. 34874-096.

Date: December 14, 2009



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Exhibit A

| 10/816,445 | MESSAGING PROTOCOL IN ENTERPRISE APPLICATIONS | 12-14-2009:13:16:58 |
|-----------------------------------------------------------------|---------------------------------------------------------|-----------------------------------------|
| Patent Term Adjustments | | |
| Patent Term Adjustment (PTA) for Application Number: 10/816,445 | | |
| Filing or 371(c) Date: | 03-31-2004 | USPTO Delay (PTO) Delay (days): 883 |
| Issue Date of Patent: | - | Three Years: - |
| Pre-Issue Petitions (days): | +0 | Applicant Delay (APPL) Delay (days): 49 |
| Post-Issue Petitions (days): | +0 | Total PTA (days): 834 |
| USPTO Adjustment(days): | +0 | Explanation Of Calculations |
| Patent Term Adjustment History | | |
| Date | Contents Description | PTO(Days) APPL(Days) |
| 09-15-2009 | Mail Notice of Allowance | |
| 09-13-2009 | Notice of Allowance Data Verification Completed | |
| 09-13-2009 | Document Verification | |
| 06-19-2009 | Information Disclosure Statement considered | |
| 06-19-2009 | Information Disclosure Statement (IDS) Filed | |
| 07-09-2009 | Date Forwarded to Examiner | |
| 06-19-2009 | Response to Election / Restriction Filed | |
| 06-19-2009 | Information Disclosure Statement (IDS) Filed | |
| 05-19-2009 | Mail Restriction Requirement | |
| 05-19-2009 | Requirement for Restriction / Election | |
| 03-23-2009 | Date Forwarded to Examiner | |
| 02-13-2009 | Response after Non-Final Action | |
| 01-29-2009 | Mail Examiner Interview Summary (PTOL - 413) | |
| 01-26-2009 | Examiner Interview Summary Record (PTOL - 413) | |
| 11-13-2008 | Mail Non-Final Rejection | |
| 11-10-2008 | Non-Final Rejection | |
| 10-07-2008 | Case Docketed to Examiner in GAU | |
| 09-10-2008 | Date Forwarded to Examiner | |
| 09-10-2008 | Date Forwarded to Examiner | |
| 09-04-2008 | Request for Continued Examination (RCE) | 49 |
| 09-10-2008 | DISPOSAL FOR A RCE/CPA/129 (express abandonment if CPA) | ↑ |
| 09-04-2008 | Request for Extension of Time - Granted | ↑ |
| 09-04-2008 | Workflow - Request for RCE - Begin | ↑ |
| 04-17-2008 | Mail Final Rejection (PTOL - 326) | ↑ |
| 04-15-2008 | Final Rejection | |
| 04-15-2008 | Case Docketed to Examiner in GAU | |
| 01-28-2008 | Date Forwarded to Examiner | |
| 01-02-2008 | Response after Non-Final Action | |
| 10-31-2007 | Mail Non-Final Rejection | 883 |
| 10-29-2007 | Non-Final Rejection | ↑ |

| | | |
|------------|---------------------------------------------------------|---|
| 10-29-2007 | Case Docketed to Examiner in GAU | ↑ |
| 09-10-2007 | Case Docketed to Examiner in GAU | ↑ |
| 07-06-2007 | Case Docketed to Examiner in GAU | ↑ |
| 09-27-2006 | Correspondence Address Change | ↑ |
| 09-27-2006 | Change in Power of Attorney (May Include Associate POA) | ↑ |
| 06-06-2006 | Case Docketed to Examiner in GAU | ↑ |
| 06-10-2004 | New or Additional Drawing Filed | ↑ |
| 09-08-2004 | Transfer Inquiry to GAU | ↑ |
| 08-18-2004 | IFW TSS Processing by Tech Center Complete | ↑ |
| 06-14-2004 | Transfer Inquiry to GAU | ↑ |
| 06-11-2004 | Application Return from OIPE | ↑ |
| 06-11-2004 | Application Return TO OIPE | ↑ |
| 06-10-2004 | Application Dispatched from OIPE | ↑ |
| 06-14-2004 | Application Is Now Complete | ↑ |
| 05-04-2004 | Cleared by OIPE CSR | ↑ |
| 04-14-2004 | IFW Scan & PACR Auto Security Review | ↑ |
| 03-31-2004 | Initial Exam Team nn | ↑ |

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